



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,897	11/30/2000	Mindy D. Goldsborough	45858/55672	9257

21874 7590 06/13/2005

EDWARDS & ANGELL, LLP  
P.O. BOX 55874  
BOSTON, MA 02205

EXAMINER
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SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Interview Summary</b>	<b>Application No.</b> 09/725,897	<b>Applicant(s)</b> GOLDSBOROUGH ET AL.	
	<b>Examiner</b> Bradley L. Sisson	<b>Art Unit</b> 1634	

All participants (applicant, applicant's representative, PTO personnel):

(1) Bradley L. Sisson. (3)\_\_\_\_\_

(2) Kathryn A. Piffat, Ph.D. (4)\_\_\_\_\_

Date of Interview: 08 June 2005.

Type: a) ☐ Telephonic b) ☐ Video Conference  
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: Draft claim 1, submitted via facsimile 6/7/05.

Identification of prior art discussed: \_\_\_\_\_


Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The aspect of amending claim 1 such that it reflects that one is >>contacting cells and virus with a dry solid medium<< wherein the dry solid medium has a detergent or surfactant sorbed thereto was discussed. Dr. Piffat indicated that the solid medium is able to bind nucleic acids even when dry, utilizing the moisture found in the cell. Attention was directed to Example 1, which teaches the pressing of plant tissue on FA GeneCards.

The aspect of using FTA Gene Cards was discussed, with attention being directed to page 7, lines 23-28, of the disclosure.

The objections to the specification were discussed. Mr. Sisson noted that the substitute specification of 13 January 2005 was not entered, and that the current specification is that which was submitted 04 May 2004. Mr. Sisson noted that while the specification makes reference to numerous documents, which have been asserted as being improperly incorporated by reference, the same documents can be used to establish the level of skill in the art and to what extent certain aspects or methodologies were well known. Mr. Sisson invited applicant to file a declaration showing that the material sought to be introduced by amendment were in fact well known and as such do not have to be entered into the instant specification via amendment, thereby avoiding the issue of new matter and having documents improperly incorporated by reference (e.g., passage found at page 32 of the original specification).

The aspect of priority was discussed. It was agreed that there is copendency between the applications, however, the manner in which the various documents are related is unclear. Mr. Sisson suggested that applicant consider perfecting their claim for benefit of priority, noting that all applications in the chain must reflect the same relationship and claim for benefit.

Dr. Piffat indicated that applicant will likely file an RCE by July 13th. .

**Edwards & Angell LLP**

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**DRAFT****Date :** 06/07/2005**Pages (including cover) :** 5**Sender :**

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Name	Kathryn A. Piffat, Ph.D.		
Fax	(001) 617.439.4170	Phone	(001) 617.439.4444
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**To :**

Name	Company	Fax	Phone
Examiner Bradley Sisson	U.S. Patent & Trademark Office, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	571.273.0751	571.272.0751

If you experience problems receiving this fax, please call Kathryn Piffat (on June 7) or Sharon Bizokas (on June 8) at 617.439.4444.

**Message :**

PLEASE CONFIRM RECEIPT: (617) 439-4444 or fax to (617) 439-4170.

Thank you!

**Fax**

**Confidentiality Note :** The documents accompanying this facsimile contain information from the law firm of Edwards & Angell LLP, which may be confidential and/or privileged. The information is intended only for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this facsimile is strictly prohibited, and that the documents should be returned to this firm immediately. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.

Practitioner's Docket No. 45858/55672

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

SERIAL NO. 09/725,897

GROUP ART UNIT: 1634

FILED: November 30, 2000

FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF NUCLEIC ACIDS USING  
A SOLID SUPPORT

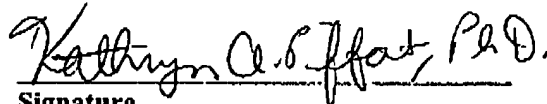
[ ] \*Patent No.: N/A Issue Date: N/A

\*NOTE: Insert name(s) of all inventor(s) and also title for patent.

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## CERTIFICATION OF FACSIMILE TRANSMISSION and TRANSMITTAL LETTER

I hereby certify that the following papers are being facsimile transmitted to the U.S. Patent and Trademark Office to Fax No.: 571-273-0751, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 7, 2005.

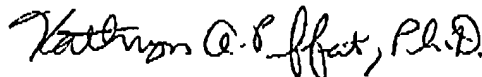


Signature

Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)

(type or print name of person signing certification)

In accordance with my recent telephone conferences with Examiner Bradley Sisson (Art Unit 1634), I am faxing the attached items, including a cover sheet (1 page); this certificate of facsimile transmission and transmittal letter for the present transmission (1 page); and a Letter providing a proposed claim amendment (3 pages). Please confirm receipt of this transmission and notify us if you require a hard copy of any or all of these items. We very much appreciate your assistance in this matter. In the event that there is a problem with the transmission, please contact the undersigned on June 7 or the undersigned's assistant, Sharon Bizokas at 617-517-5598 or 617-439-4444 on June 8.



Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)

Telephone: (617) 439-4444; Facsimile: (617) 439-4170

Customer No. 21874

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(Certification of Facsimile Transmission--Page 1 of 1)

Docket No. 45858/55672

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

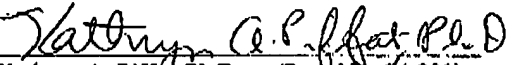
SERIAL NO. 09/725,897

GROUP ART UNIT: 1634

FILED: November 30, 2000

FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF  
NUCLEIC ACIDS USING A SOLID SUPPORTCommissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450\*\*\*\*\*  
CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the U.S. Patent and Trademark Office at Fax No.: 571-273-0751, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 7, 2005.

  
Kathryn A. Piffa, Ph.D. (Reg. No. 34,901)  
(type or print name of person signing certification)

\*\*\*\*\*  
Sir:LETTER

This **LETTER** is being submitted to the Office in response to a request from Examiner Sisson prior to a conference with the Examiner to take place on 8 June 2005 ("conference").

During the conference, the undersigned would like to discuss the proposed draft claim (attached) and see what changes, if any, will help the Office consider it on the merits in an RCE.

Support for the draft claim 1 can be found in the application (including the specification, figures, claims) as originally filed, such as on pages 7-24, in the Examples, and in the original and amended claims.

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Support for draft claim 1 can be found throughout the specification as originally filed, particularly on pages 7-12. Additional support for draft claim 1 can be found from page 7, lines 21, to page 8, lines 2; on page 8, lines 24-26; from page 9, line 5, to page 12, line 20; from page 13, line 12, to page 15, line 2; from page 18, line 20, to page 19, line 18; on page 28, lines 7-8; and in the Examples.

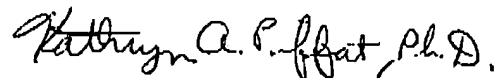
The present submission is for discussion purposes only. It should not be construed as a surrender of any subject matter. Further, proposed amendments are not being suggested in the face of any issue related to patentability.

The undersigned also wishes to clarify the current status of the specification and the amendments thereto.

Applicants believe no fee is needed to consider this **LETTER**. However, if a fee is deemed necessary, the Office is authorized to debit our deposit account 04-1105 for such fee.

Respectfully submitted,

Date: June 7, 2005



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APPENDIX ADRAFT CLAIM-FOR DISCUSSION PURPOSES ONLY*DRAFT*

- [to produce]*
1. A method ~~of producing~~ *cell or vir. w/ a dry solid medium* one or more cDNA molecules comprising:
- (a) contacting a sample comprising a cell or a virus with a solid medium, wherein:
    - (i) the cell or the virus comprises mRNA and genomic DNA;
    - (ii) the mRNA comprises an mRNA template of interest; and
    - (iii) wherein the solid medium comprises:
      - a matrix; and
      - a composition for inhibiting degradation of the mRNA template, wherein:
        - and dried prior to contact w/ sample*
        - the composition is sorbed to the matrix; and
        - the composition comprises a detergent or surfactant;
  - (b) sorbing at least a portion of the mRNA template to the solid medium;
  - (c) eluting the mRNA from the solid medium while retaining the genomic DNA; and
  - (d) contacting the mRNA with one or more reverse transcriptases under conditions sufficient to synthesize one or more cDNA molecules complementary to all or a portion of the mRNA template of interest.

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